



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. :	09/867,223	Docket No. :	11032/3073
Inventor :	Jonathan BARSADE et al.	Confirmation No. :	5920
Filed :	May 29, 2001	Customer No. :	23838
Examiner :	Yehdega RETTA	Art Unit :	3622

For : NETWORK BANNER ADVERTISEMENT SYSTEM AND METHOD

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**Attention: Board of Patent Appeals and Interferences**

**APPEAL BRIEF UNDER 37 C.F.R. §41.37**

Sir:

Appellants submit this Appeal Brief in the above-referenced application. A Notice of Appeal was filed on June 27, 2007. All fees associated with this appeal are authorized to be charged to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

**REAL PARTY IN INTEREST**

DoubleClick, Inc. is the real party in interest for all issues related to this application.

**RELATED APPEALS OR INTERFERENCES**

There are no other appeals, interferences, or judicial proceedings known to Appellants, Appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## **STATUS OF CLAIMS**

Claims 1-42 are pending in this application and are the subject of this appeal. Claims 1-42 stand finally rejected as obvious over prior art.

## **STATUS OF AMENDMENTS**

None of the claims are amended after the February 27, 2007 final Office Action.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

Independent claim 1 recites a method of providing to a user computer (User 1-6, Fig. 1, p. 8, lines 1-13) connected to a network (Fig. 1, p. 8:1-13) an advertisement for a network browser session (S7, Fig. 1, p. 8:1-3 and 11-13), comprising requesting a new network data stream for display in the first network browser session (User request, Figs. 2-4, p. 8:14-21); serving up to a second network browser session an advertisement data stream previously stored in the memory of the user computer connected to the network thereby forming an advertisement (BA display, Figs. 2-4, p. 8:21-23); and downloading to the user computer, from a server on the network, the requested new network data stream which is viewable in the first network browser session (load requested page, Figs. 2-4, p. 8:19-23). The advertisement is served up while the new network data stream is being downloaded to the user computer (serve BA while page is loading, Figs. 2-4, p. 21-23) and in association with a displayable status indicator of the concurrent downloading activity of the new network data stream (p. 4:26 – 5:13, 8:23-27). The advertisement data stream was downloaded onto the memory of the user computer prior to the step of requesting a new network data stream (Figs. 3-4, p. 8:21-23, p. 9:16-12:19). The first and second network browser sessions are the same session or different sessions (p. 8:23, 9:7-8).

Independent claim 17 recites an electronic advertising system comprising plural network servers (S1-S7, Fig. 1, p. 8:1-3), at least a first server of which includes plural advertisement (BA) data streams stored in a first memory (S7, Fig. 1, p. 8:2-3 and 11-13) and at least a second server of which includes plural network data streams in a second memory (S1-S6, Fig. 1, p. 8:7-11); and plural user computers, each of which comprises a third memory, a display component, a browser program, and an integrated circuit (User 1 – User 6, Fig. 1, p. 8:1-13, 16:8-15) and each

of which comprises a respective first BA data stream in the third memory (Store BA on user computer, Figs. 3-4, p. 8:21-23, p. 9:16-12:19). The plural servers and plural user computers form a network (Fig. 1, p. 8:1-13). The browser program and central processing unit can process BA data streams and network data streams for display (Figs. 2-4, p. 8:1-13, 9:16 – 12:19). The browser program of a first user computer serves up the first BA data stream to a window for display as a first advertisement during the approximate period of time that occurs between when the first user computer requests a second network data stream from the second server and the second network data stream is completely downloaded onto the first user computer (Fig. 2, p. 8:14 – 9:15). The first advertisement is served up in association with a displayable status indicator of the concurrent downloading activity of the second network data stream (p. 4:26 – 5:13, 8:23-27).

Independent claim 24 recites an electronic advertisement for a network, the advertisement comprising one or more advertisement portions displayed in a window of a browser program of a user computer (p. 4:5-12, 5:28 – 6:2, 7:5-17, 8:20-23). The advertisement is displayed in the window during the approximate period of time beginning about when the user computer requests a first network data stream from a network server and ending about when the first network data stream is downloaded onto the user computer and is ready for viewing as a first network data stream in the same or a different window of the browser (Fig. 2, p. 8:14 – 9:15). The advertisement is created from an advertisement data stream previously stored in the memory of the user computer, the advertisement data stream having been obtained from a network server prior to the point in time in which the user computer requests the first network data stream Store BA on user computer, Figs. 3-4, p. 8:21-23, p. 9:16-12:19, wherein the advertisement portion is viewable, audible or a combination thereof (p. 7:17-29). The advertisement is served up to the window in association with a displayable status indicator of the concurrent downloading activity of the first network data stream (p. 4:26 – 5:13, 8:23-27).

Independent claim 31 recites a method of advertising on a network comprising providing at least one first network server comprising a first memory having a plurality of advertisement (BA) data streams stored therein (S7, Fig. 1, p. 8:2-3 and 11-13); providing at least one second network server comprising a second memory having a plurality of network data streams stored therein, wherein at least one of the network data streams includes a BA activation code (S1-S6,

Fig. 1, p. 8:7-11, 14:28 – 15:17); providing at least one user computer comprising a third memory, an integrated circuit unit, a browser program and a display component (User 1 – User 6, Fig. 1, p. 8:1-13, 16:8-15); submitting a request from the user computer to the second network server for a first network data stream that includes a BA activation code (p. 14:28 – 15:17); downloading the requested first network data stream from the second network server to the user computer such that a first network data stream is displayed in a first window of the browser program (User request, Figs. 2-4, p. 8:14-21); and submitting a request to the first network server for a first BA data stream, wherein the request is initiated by the BA activation code p. 14:28 – 15:17; and downloading the first BA data stream from the first network server to the user computer such that the first BA data stream is stored in the third memory in association with code for displaying a status indicator of concurrent downloading activity of a network data stream, wherein the first and second network servers are the same or different (p. 4:26 – 5:13, 8:23-27).

### **GROUND OF REJECTION TO BE REVIEWED**

The final rejection rejects claims 1-42 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,011,537 (“Slotznick ’537”) in view of U.S. Patent No. 6,609,146 (“Slotznick ’146”).

### **ARGUMENT**

Claims 1-42: Slotznick ’146 Does Not Teach or Suggest An Advertisement Served In Association With A Displayable Status Indicator Of Concurrent Download Activity Of A New Network Data Stream.

Independent claim 1 recites, in relevant part, an advertisement “served up...in association with a displayable status indicator of the concurrent downloading activity of the new network data stream.” The remaining independent claims recite similar language. In a final Office Action mailed February 27, 2007 (“Final Rejection”), the Examiner admits that Slotznick ’537 fails to teach downloading a displayable status indicator of concurrent downloading activity of a

new network data stream, but asserts that this feature is disclosed by Slotznick '146 at column 4, lines 20-28.

However, this passage of Slotznick '146 merely indicates that some programs provide an estimate of processing times. There is no suggestion that this estimated processing time is ever displayed in association with an advertisement. Slotznick '146 provides specific examples of what a user may select for display during processing by a program, such as a schedule or a full-length movie. *See* col. 4, lines 20-28. Notably, there is no mention of displaying an advertisement during this processing time. A general statement that estimated processing time of a download can be displayed fails to suggest serving up an advertisement in association with a displayable status indicator of concurrent downloading activity as required by the claims.

In fact, Slotznick '146 teaches away from displaying an advertisement during this time. Slotznick '146 describes a system for minimizing a first application and displaying a second application while the first application is processing. *See, e.g.*, col. 3, line 34 – col. 4, line 9. One of the uses for this system is **blocking** interstitial advertisements:

The devices and methods that are the subject of this patent application not only have a use in their own right of switching between programs or information objects or information streams, but also in the setting of Internet or other network usage, said devices and methods will filter or block 5 interstitial advertisements or other interstitial information objects by substituting something (e.g., a blank screen or wallpaper, an alternate program or screen-saver, etc.) during the interstitial time. These devices and methods thereby overwrite and hence block or filter the advertisement or 10 information object embedded in the web page or otherwise downloaded data from the network.

Col. 5, lines 1-12 (emphasis added). Although Slotznick '146 indicates that some advertisements associated with some web sites may be permitted (col. 5, lines 13-29), there is no suggestion that advertisements should be selected and displayed in association with a displayable status indicator of concurrent downloading activity as required by the claims. Slotznick '146 teaches that it is desirable to block advertisements, and thus teaches away from actively storing, selecting and displaying advertisements. Therefore, it would not have been obvious to one of skill in the art to

use the advertisement-blocking technology of Slotznick '146 to display advertisements in the system of Slotznick '537. For at least this reason, claims 1-42 are allowable over the cited art, and the rejection of these claims should be reversed.

Claims 31-42: The Cited Art Does Not Disclose An Activation Code.

Claim 31 recites, in relevant part:

- a) providing at least one first network server comprising a first memory having a plurality of advertisement (BA) data streams stored therein;
- b) providing at least one second network server comprising a second memory having a plurality of network data streams stored therein, wherein **at least one of the network data streams includes a BA activation code**;
- ...
- d) submitting a request from the user computer to the second network server for a first network data stream that **includes a BA activation code**; and
- ...
- f) submitting a request to the first network server for a **first BA data stream**, wherein the request is **initiated by the BA activation code**.

The use of a BA activation code is further described in the specification at page 14, line 28 through page 15, line 17. As an example, a BA activation code can give subscribers to an advertisement service provider network control over when and how one of their advertisements is displayed.

The Examiner asserts without explanation that Slotznick '537 discloses these features at Figure 12; column 29, lines 15-43; column 31, line 19 to column 32, line 14; column 33, lines 4-22; and column 36, lines 1-9. It isn't clear specifically which items in the cited portions the Examiner believes describe a BA activation code. However, a close examination of Slotznick '537 shows that these passages merely describe basic programming concepts and structures that are common to most web browser implementations. For example, column 31, line 19 to column 32, line 14 describes problems faced by programmers when trying to create a "persistent" environment in web browsers, and the use of common programming techniques such as caching. The other passages similarly describe concepts such as the inclusion of images and banners in a web page (Fig. 12, col. 29:15-43, col. 36:1-9) and the use of web browser plug-ins (col. 33:4-22).

The cited disclosure is simply unrelated to the BA activation code recited in the claims. Further, the Examiner has not met the required burden to show how the Slotznick '537 discloses the features recited in the claims, or how one of skill in the art could adapt or modify Slotznick '537 to achieve the claimed features. The Final Rejection therefore fails to present a *prima facie* case of obviousness, and the rejection of claims 31-42 should be reversed.

## **CONCLUSION**

Appellants respectfully request reversal of the rejections of claims 1-42. For at least the reasons discussed above, these claims are allowable over the cited art.

Respectfully submitted,

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## **CLAIMS APPENDIX**

1. A method of providing to a user computer connected to a network an advertisement for a network browser session, the method comprising the steps of:

- a) requesting a new network data stream for display in the first network browser session;
- b) serving up to a second network browser session an advertisement data stream

previously stored in the memory of the user computer connected to the network thereby forming an advertisement;

- c) downloading to the user computer, from a server on the network, the requested new network data stream which is viewable in the first network browser session;

wherein, the advertisement is served up while the new network data stream is being downloaded to the user computer and in association with a displayable status indicator of the concurrent downloading activity of the new network data stream, the advertisement data stream was downloaded onto the memory of the user computer prior to the step of requesting a new network data stream, and the first and second network browser sessions are the same session or different sessions.

2. The method of claim 1 further comprising the step of:

- a) storing the advertisement data stream in the memory of the user computer while waiting for a previous network data stream to download to the computer or while a previous network data stream was displayed in the browser session;

which step occurs prior to the requesting step.



3. The method of claim 2, wherein the first and second network browser sessions are the same.
4. The method of claim 3, wherein the window of the network browser session is a multi-frame window, and step c) comprises the step of serving up to one or more frames of the multi-frame window the advertisement data stream previously stored in the memory of the user computer connected to the network.
5. The method of claim 4, wherein the one or more frames that contain the served up advertisement data stream together comprise at least a major portion of the window of the network browser session.
6. The method of claim 2, wherein the first and second network browser sessions are different.
7. The method of claim 6, wherein the window of the second network browser session comprises a multi-frame window, and step c) comprises the step of serving up to one or more frames of the multi-frame window the advertisement data stream previously stored in the memory of the user computer connected to the network.
8. The method of claim 7, wherein the one or more frames that contain the advertisement data stream together comprise at least a major portion of the window of the second network browser session.

9. The method of claim 6, wherein the window of the second network browser session comprises a single frame window.
10. The method of claim 9, wherein the advertisement comprises at least a major portion of the single frame window.
11. The method of claim 2 further comprising the step of:
- a) requesting from a server on the network a second advertisement;
- which step occurs concurrently with or after completion of the step of downloading of the requested new network data stream.
12. The method of claim 11 further comprising the step of:
- a) storing the second advertisement data stream in the memory of the computer and deleting the first advertisement from the memory of the computer;
- which step occurs after initiation of the step of requesting the second advertisement.
13. The method of claim 11, wherein the requested network data stream comprises software language that requests the second advertisement.
14. The method of claim 1, wherein the requested network data stream comprises software language that requests the second advertisement.

15. The method of claim 2 further comprising the step of:
- a) activating one or more links in the advertisement.
16. The method of claim 1 further comprising the step of:
- d) serving up to the first network browser session the requested network data stream,
- which step can occur after step b) or step c).
17. An electronic advertising system comprising:
- a) plural network servers, at least a first server of which includes plural advertisement (BA) data streams stored in a first memory and at least a second server of which includes plural network data streams in a second memory; and
  - b) plural user computers, each of which comprises a third memory, a display component, a browser program, and an integrated circuit and each of which comprises a respective first BA data stream in the third memory; wherein,
  - c) the plural servers and plural user computers form a network;
  - d) the browser program and central processing unit can process BA data streams and network data streams for display; and
  - e) the browser program of a first user computer serves up the first BA data stream to a window for display as a first advertisement during the approximate period of time that occurs between when the first user computer requests a second network data stream from the second server and the second network data stream is completely downloaded onto the first user computer,
- wherein the first advertisement is served up in association with a displayable status indicator of

the concurrent downloading activity of the second network data stream.

18. The system of claim 17, wherein the first BA data stream is replaced with a second BA data stream obtained from the first server after the second network data stream has been completely downloaded or while the second network data stream is being downloaded onto the user computer.

19. The system of claim 17, wherein at least one of the plural network data streams comprises embedded code identifying a specific BA data stream to be downloaded onto the user computer.

20. The system of claim 17, wherein at least one of the plural network data streams comprises embedded code requesting an unspecified BA data stream to be downloaded onto the user computer, wherein the unspecified BA data stream belongs to a specific genus, group, subgroup, class and/or subclass of BA data streams.

21. The system of claim 17, wherein the browser program is displaying at least two windows, a first window of which includes the first advertisement and a second window of which includes the first or second network data streams.

22. The system of claim 17, wherein the browser program is displaying a single window comprising the first advertisement or the first or second network data streams.

**23.** The system of claim 22, wherein the first advertisement is included in the window approximately until the point in time that the second network data stream is ready for display.

**24.** An electronic advertisement for a network, wherein the advertisement comprises one or more advertisement portions displayed in a window of a browser program of a user computer and the advertisement is:

a) displayed in the window during the approximate period of time beginning about when the user computer requests a first network data stream from a network server and ending about when the first network data stream is downloaded onto the user computer and is ready for viewing as a first network data stream in the same or a different window of the browser;

b) created from an advertisement data stream previously stored in the memory of the user computer, the advertisement data stream having been obtained from a network server prior to the point in time in which the user computer requests the first network data stream, wherein the advertisement portion is viewable, audible or a combination thereof; and

c) served up to the window in association with a displayable status indicator of the concurrent downloading activity of the first network data stream.

**25.** The advertisement of claim 24, wherein the advertisement comprises a major portion of the window.

**26.** The advertisement of claim 24, wherein the first network data stream and the advertisement are in two different windows.

27. The advertisement of claim 24, wherein the first network data stream and the advertisement are in the same window.
28. The advertisement of claim 24, wherein at least one of the plural network data streams comprises embedded code identifying a specific BA data stream to be downloaded onto the user computer.
29. The advertisement of claim 24, wherein at least one of the plural network data streams comprises embedded code requesting a BA data stream but not identifying a specific BA data stream.
30. The advertisement of claim 24, wherein the BA data stream is a data stream cluster comprising two or more data stream types selected from the group consisting of html file, text file, graphics file, executable script, java script file, active-X file, flash file, multi-media file, video file, music file, audio file, CGI script, macro-media director file, Real file, QuickTime file, mpeg file, tiff file, gif file, pdf file, MIDI file, and plug-in file.
31. A method of advertising on a network comprising the steps of:
- a) providing at least one first network server comprising a first memory having a plurality of advertisement (BA) data streams stored therein;
  - b) providing at least one second network server comprising a second memory having a plurality of network data streams stored therein, wherein at least one of the network data streams includes a BA activation code;

- c) providing at least one user computer comprising a third memory, an integrated circuit unit, a browser program and a display component;
- d) submitting a request from the user computer to the second network server for a first network data stream that includes a BA activation code;
- e) downloading the requested first network data stream from the second network server to the user computer such that a first network data stream is displayed in a first window of the browser program and;
- f) submitting a request to the first network server for a first BA data stream, wherein the request is initiated by the BA activation code; and
- g) downloading the first BA data stream from the first network server to the user computer such that the first BA data stream is stored in the third memory in association with code for displaying a status indicator of concurrent downloading activity of a network data stream, wherein the first and second network servers are the same or different.

**32.** The method of claim 31 further comprising the steps of:

- h) submitting a request from the user computer to the second network server for a second network data stream that optionally includes a BA activation code;
- i) serving up the first BA data stream stored in the third memory to the browser program such that an advertisement is viewable in a second window of the browser program;
- j) downloading the requested second network data stream from the second network server to the user computer such that a second network data stream is displayed in the first window of the browser program; and
- k) displaying the requested second network data stream at a higher status than the

advertisement.

**33.** The method of claim 32 further comprising the steps of:

l) submitting a request from the user computer to the first network server for a second BA data stream, wherein the request is initiated by a BA activation code embedded in second network data stream; and

m) downloading the second BA data stream from the first network server to the user computer such that the second BA data stream is stored in the third memory.

**34.** The method of claim 32, wherein the first and second windows are different windows and the first window remains open and the second window is closed.

**35.** The method of claim 32, wherein the first and second windows are stacked and are different windows and the first window is anterior to the second window.

**36.** The method of claim 32, wherein the first and second windows are tiled and are different windows and the first window is superior to the second window.

**37.** The method of claim 32, wherein the first and second windows are the same.

**38.** The method of claim 37, wherein the content of the network data stream is superior to the content of the BA.



39. The method of claim 32, wherein the third memory of the at least one user computer comprises a second BA data stream prior to the step d).

40. The method of claim 39 further comprising the steps of:  
replacing the second BA data stream with the first BA data stream.

41. The method of claim 40 further comprising the steps of:

i) submitting a request from the user computer to the second network server for a second network data stream that optionally includes a BA activation code;

j) serving up the first BA data stream stored in the third memory to the browser program such that an advertisement is viewable in a second window of the browser program;

k) downloading the requested second network data stream from the second network server to the user computer such that a second network data stream is viewable in the first window of the browser program; and

l) displaying the first window at a higher status than the second window.

42. The method of claim 41 further comprising the steps of:

m) submitting a request from the user computer to the first network server for a third BA data stream, wherein the request is initiated by a BA activation code embedded in second network data stream; and

n) downloading the third BA data stream from the first network server to the user computer such that the third BA data stream is stored in the third memory and replaces the first BA data stream.

## **EVIDENCE APPENDIX**

No evidence under 37 C.F.R. §§ 1.130, 1.131, or 1.132 was submitted in this application.

### **RELATED APPEALS APPENDIX**

There are no other appeals, interferences, or judicial proceedings known to Appellants, Appellants' legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.